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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/700,802  | 11/03/2003  | Thomas Poslinski     | 81099/7114          | 6271             |
| 37123 7590 07/09/2008<br>FITCH EVEN TABIN & FLANNERY<br>120 SOUTH LASALLE SUITE 1600<br>CHICAGO, IL 60603 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| SHIBRU, HELEN   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 2621  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 07/09/2008  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/700,802

**Applicant(s)**

POSILINSKI ET AL.

**Examiner**

HELEN SHIBRU

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 11-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8, 11-14 and 16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to the method of increasing the available storage space on an electronic storage medium comprising the steps of "creating and storing in a memory a free memory list for the electronic storage medium;... copying the selected first portion of the file to the free memory list without copying a second portion of the file and leaving a deallocated portion of memory corresponding to the first portion." classified in class 709, subclass 215.
  - II. Claims, 8 and 11-12 drawn to a method of increasing the available storage space on a PVR comprising "receiving a signal for marking a starting flag for the first media file, the starting flag indicating a starting point located anywhere in the first media file; receiving a signal for marking an ending flag for the first media file , the ending flag indicating an ending point located anywhere in the first media file; deleting the portion of the first media file between the starting flag and the ending flag....", classified in class 386, subclass 55.
  - III. Claims 13-14 and 16 drawn to a method of increasing the available storage space on a personal video recorder comprising the steps of "searching for a start program time stamp marking a starting point located anywhere in a first video file; searching for a first full image frame related to the start program time stamp; searching for an end program time stamp marking a ending point located anywhere in a first video file the video file; searching for a second full image frame related to the end program time stamp; and deleting a portion of the first video file between the first full image frame and the second full image frame...", classified in class 386, subclass 65.
2. The inventions are distinct, each from the other because of the following reasons:

Groups I-III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the method of increasing the available storage space on an electronic storage medium as claimed in claim 1 does not require the features of “receiving a signal for marking a starting flag for the first media file, the starting flag indicating a starting point located anywhere in the first media file; receiving a signal for marking an ending flag for the first media file, the ending flag indicating an ending point located anywhere in the first media file; deleting the portion of the first media file between the starting flag and the ending flag” as recited in claim 8, group II, and “searching for a start program time stamp marking a starting point located anywhere in a first video file; searching for a first full image frame related to the start program time stamp; searching for an end program time stamp marking an ending point located anywhere in a first video file the video file; searching for a second full image frame related to the end program time stamp; and deleting a portion of the first video file between the first full image frame and the second full image frame” as claimed in claim 13, group III.

Similarly, the method of increasing the available storage space on a PVR as recited in group II does not require the features of “creating and storing in a memory a free memory list for the electronic storage medium; copying the selected first portion of the file to the free memory list without copying a second portion of the file and leaving a deallocated portion of memory corresponding to the first portion” as claimed in claim 1, group I, and “searching for a start program time stamp marking a starting point located anywhere in a first video file; searching for a first full image frame related to the start program time stamp; searching for an end program time stamp marking an ending point located anywhere in a first video file the video file; searching for a second full

image frame related to the end program time stamp; and deleting a portion of the first video file between the first full image frame and the second full image frame” as claimed in claim 13, group III.

Finally the method of increasing the available storage space on a personal video recorder does not require the features of “creating and storing in a memory a free memory list for the electronic storage medium; copying the selected first portion of the file to the free memory list without copying a second portion of the file and leaving a deallocated portion of memory corresponding to the first portion” as claimed in claim 1, group I, and “receiving a signal for marking a starting flag for the first media file, the starting flag indicating a starting point located anywhere in the first media file; receiving a signal for marking an ending flag for the first media file, the ending flag indicating an ending point located anywhere in the first media file; deleting the portion of the first media file between the starting flag and the ending flag” as recited in claim 8, group II.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/  
Examiner, Art Unit 2621  
June 27, 2008

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621